Remarks

Reconsideration and allowance of this application are respectfully requested in view of the following arguments.

Original claims 1-14 were rejected by the Examiner under 35 U.S.C. 102(e) as being anticipated by Vert et al. The original claims have not been amended, nor have any new claims been added.

It is well established that "A claim is anticipated under 35 U.S.C. 102 only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. V. Union Oil Co. of California, 814 F2nd 628, 631, 2 USPQ2d1051, 1053 (Fed. Cir. 1987) (see also MPEP 2131).

Additionally, as held in the recent CAFC decision, Trintec Industries, Inc. v. Top-U.S.A. Corp (CAFC 7/2/02), "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." In re Robertson, 169, F.3d 743 45 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Still further, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijakaert, 9F.3d, 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "In relying upon the theory of inherency, the examiner must provide a basis in

fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. Ap. & Inter. 1990) (emphasis in original). (Also see MPEP 2112).

Additionally note the recent CAFC decision Elan Pharmaceuticals v. Mayo Foundation for Medical Education and Research, 68 USPQ2d 1373 (CAFC, Oct. 2, 2003) which holds that: "The disclosure in an anticipating reference must be adequate to enable the desired subject matter. It is insufficient to name or describe the desired subject matter, if it cannot be produced without undue experimentation."

The Examiner's 35 U.S.C. 102(e) rejection of claims 1-14 based on Vert will be examined to determine whether the rejection complies with the requirements of 35 U.S.C. 102(e) set forth above.

Claims 1 and 8 (the only independent claims)

Recitation "a":

On page 2 of the Action, the Examiner refers to page 1, paragraph 4 as meeting recitation "a" of claims 1 and 8. This recitation requires "initiating a thread for effecting the transition." An examination of page 1, paragraph 4 reveals no mention of using the initiation of a thread for effecting the transition. This does not meet the 35 U.S.C. 102 requirement that such teaching necessarily be present in Vert or necessarily flows from the teachings of Vert. It is noted that the Examiner does not provide a basis in fact

and/or technical reasoning to reasonably support that recitation "a" necessarily flows from the teachings of Vert.

Recitation "b":

On page 2 and 3 of the Action, the Examiner refers to page 3, paragraph 29 and page 4, paragraph 30 as meeting recitation "b" which requires "determining if a shared resource is owned by said second node." An examination of these paragraphs does not reveal that this determining step is performed by Vert, or that it is necessary that it be performed, nor does the Examiner provide a basis in fact and/or technical reasoning to reasonably support that this recitation necessarily flows from the teachings of Vert.

Recitation "c":

On pages 2 and 3 of the Action, the Examiner uses the above referenced portions of Vert to allege that this "calling a driver" recitation is met. However, it is not seen where these referenced portions of Vert mention use of a "driver" in the first instance in the manner required by recitation "c", mush less that such use is necessarily required.

Claims 2 and 9:

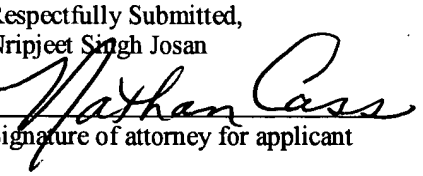
On page 3 of the Action, the Examiner refers to page 1, paragraph 3 as meeting the "counting" step in claims 2 and 9. The Examiner states that "it is implied that if a system in the cluster that takes over a group (collection of resources) from a failed system is overloaded, then that

system can balance its workload among different servers in the cluster. In order to determine the workload of the system, the resources that it is taking over (transitioned) must be counted." Applicant respectfully submits that this statement by the Examiner does not meet the 35 U.S.C. 102 requirement that such counting as claimed is necessarily present in Vert and/or necessarily flows from the Vert's teaching of workload balancing. For example, Vert might use a load balancing approach wherein the workload of each sever is monitored. In the event a server is approaching overload, Vert could then transition a portion of its load to another server having a smaller workload. In such case, the counting recited by claims 2 and 9 would not be required.

In view of the foregoing, applicant respectfully submits that claims 1, 2, 87 and 9 are properly allowable in this application. Dependent claims 3-7 and 10-14 are thus also allowable.

Allowance of this application is accordingly respectfully solicited.

Respectfully Submitted,
Nripjeet Singh Josan



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